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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,523	11/21/2003	Martin Josso	016800-586	8425

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EXAMINER	
ALSTRUM ACEVEDO, JAMES HENRY	
ART UNIT	**PAPER NUMBER**
1616	

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,523	JOSSO, MARTIN	
	Examiner	Art Unit	
	James H. Alstrum-Acevedo	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 August 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-27,29,30 and 32-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-27, 29-30, and 32-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 3-27, 29-30, 32-55, and 57-58 are pending. Receipt and consideration of the remarks/arguments and amendments in the reply filed on August 14, 2006 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

The rejection of claims 12 and 41 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is maintained** for the reasons of record as set forth on page 4 of the office action mailed on November 30, 2005 and further explained below.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims 1, 3-6, 9-18, 25, 29-30, 32-46, 53, and 58 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) in view of Fankhauser et al. (US 2002/0155073) is **maintained** per the teachings/disclosures set forth on pages 5-6 and 10-11 of the office action mailed on November 30, 2005 and page 4 of the office action mailed on May 12, 2006.

The rejection of claims 1, 3-12, 14-25, 29-30, 32-41, and 47-52 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) in view of Torgerson et al.

(U.S. Patent No. 6,458,906) **is maintained** per the disclosures/teachings set forth on pages 5-6 and 11-13 of the office action mailed on November 30, 2005 and pages 4-5 of the office action mailed on May 12, 2006.

The rejection of claims 26-27, 54-55, and 57 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) ("Iijima") in view of Torgerson et al. (U.S. Patent No. 6,458,906) ("Torgerson") as applied to claims 1, 3-12, 14-25, 29-30, 32-41, and 47-52 above, and further in view of Candau, D. (U.S. Patent No. 6,033648) ("Candau") **is maintained** per the teachings set forth on pages 5-6 and 11-14 of the office action mailed on November 30, 2005 and pages 4-5 of the office action mailed on May 12, 2006.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The provisional rejection of claims 1, 3, 4, 9-12, 14-17, 30, 32-33, 38-41, and 43-46 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6-15, 29, and 30 of copending Application No. 10/365,653 (copending '653) **is maintained** for the reasons of record set forth on pages 6-7 of the previous office action mailed on May 12, 2006 and because Applicants' have requested that this rejection be held in abeyance.

Response to Arguments

Applicant's arguments filed August 14, 2006, regarding the rejection of claims 12 and 41 under 35 U.S.C. 112, second paragraph have been fully considered but they are not persuasive. Applicant has alleged that the claim amendments removing the term derivatives and changing "bisbenzoazolyl" to "bisbenzoazolyls" has corrected the indefiniteness of claims 12 and 41. The Examiner respectfully disagrees. Replacement of the term "bisbenzoazolyl derivatives" with "bisbenzoazolyls" is merely rewording and still suffers from the fact that said term is not defined in the specification and has an indefinite metes and bounds.

Applicant has traversed the art rejections of record based on the following arguments: the prior art does not disclose, teach, or fairly suggest (1) a device comprising (a) an emulsion and (b) a photoprotective system; (2) a means to place said composition under pressure; (3) there is not motivation in the prior art teachings to combine the references relied upon in the previous office action; and (4) Applicant has alleged a showing of unexpected results based upon additional experimental evidence. The Examiner respectfully disagrees with Applicant's arguments traversing the art rejections of record.

Regarding the Applicant's last argument, the data submitted in tabular form along with the arguments/remarks has not been considered, because said data was not provided in the form of an oath or declaration. The MPEP (See 37 C.F.R. § 1.132) clearly states,

> **§ 1.132 Affidavits or declarations traversing rejections or objections.**
> When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

Applicant's arguments (1) and (2) will be addressed together because all references utilize Iijima as the primary reference and the teachings of Iijima are sufficient to rebut Applicant's arguments. Iijima clearly teaches (see the abstract for example) (1) a composition contained in a releasing container such as **an aerosol container or pump type-releasing container**, and used as being released from such releasing container, and (2) a releasing container product containing such composition (see column 1, lines 7-11). It is known in the art that aerosol containers routinely contain pressurized formulations and therefore said formulations within such an aerosol container would obviously have a means of placing a composition under pressure, because the compositions are already under pressure. Applicant also admits in paragraph [0115] of the instant specification that aerosol containers are well known to persons of skill in the art as devices that are in accordance with Applicant's invention. Therefore, these specific limitations are addressed by the teachings of Iijima alone. Iijima also teaches that the compositions may comprise an ***ultraviolet blocker***, which constitutes a photoprotective system (abstract, col. 7, lines 15-27). Notwithstanding this, the combination of the teachings of Iijima and Fankhauser or Iijima and Torgerson most assuredly do yield compositions comprising a photoprotective system (See, for example: Fankhauser paragraphs [0007], [0065], [0099], and

[0139]; or Torgerson, col. 18, lines 5, 19-21, and Example XIX). Iijima alone and in combination also teaches emulsions, as was clearly articulated on page 8 of the previous office action mailed on May 12, 2006 (See also: Iijima, col. 12, lines 60-64 and col. 13, lines 40-42; Fankhauser, [0250]; Torgerson, col. 15, lines 50-61; and Candau, col. 11, lines 1-10).

The motivations to combine the secondary and ternary references of record with Iijima are further articulated herein. A skilled artisan would have been motivated to combine the teachings of Iijima with the teachings of Fankhauser at least because, particularly in Asiatic countries, there is great interest in light protection filters or mixtures of light protection filters which preserve the color of the skin following solar irradiation and, moreover, are able to impart a lighter appearance to the skin and Fankhauser's compositions provide this desired property (Fankhauser, [0003]). Furthermore, both Fankhauser and Iijima are generally in the same field of endeavor of cosmetic products with UV protecting properties. The fact that Iijima's invention has other utilities does not constitute a teaching away.

A skilled artisan would have been motivated to combine the teachings of Iijima with the teachings of Torgerson at least because Torgerson's invented copolymers provide topical compositions which (1) are more easily and uniformly spread upon the skin; (2) feel good upon the skin, and yet which are highly substantive; (3) are useful for enhancing the penetration of a wide variety of cosmetic and pharmaceutical actives into the skin; and (4) alternatively, through the skin for systemic delivery (col. 2, lines 5-11). The combination of Iijima and Torgerson would therefor yield compositions having desirable properties of a good feel, ease and uniformity upon application, and enhancement of the penetration of cosmetic/pharmaceutical actives, if desired.

A skilled artisan would have been motivated to combine the teachings of Iijima and Torgerson with the teachings of Candau at least because Candau's compositions comprising iron oxide nanopigments, formulated into a water-in-oil emulsion vehicle, diluent or carrier, impart to the skin, a few minutes after application thereto, an artificial coloring similar to natural tanning which is simultaneously intense, non-covering, transparent, persistent over time, and particularly resistant to water (col. 2, lines 25-34). The combination of Iijima and Torgerson with Candau would therefor yield compositions having desirable artificial tanning properties that impart to the skin a coloring that is transparent, persistent over time, and particularly resistant to water.

Conclusion

Claims 1, 3-27, 29-30, 32-55, and 57-58 are rejected. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-6:30, with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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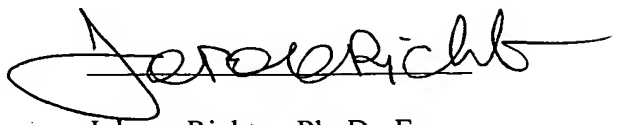

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